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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/708,441	03/03/2004	Peter Ohnemus	20118/0200853-US0	2440

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DARBY & DARBY P.C.
P. O. BOX 5257
NEW YORK, NY 10150-5257

EXAMINER

HECK, MICHAEL C

ART UNIT	PAPER NUMBER
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3623

DATE MAILED: 11/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/708,441

Applicant(s)

OHNEMUS ET AL.

Examiner

Michael C. Heck

Art Unit

3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The following is a First Office Action in response to the application filed 03 March 2004. Claims 1-55 are pending in this application and have been examined on the merits as discussed below.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 324 and 747.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 748.

4. The drawings are objected to because Figure 9 refers to Figures 10X, 11X, 12X, 13X and 14X. The said figures have alphabetic sub-figures, i.e. Figure 10A, Figure 10B, Figure 10C, Figure 10D and Figure 10E, and do not have a respective alphabetic sub-figure of "X". The Examiner request the reference to the Figures in Figure 9 represent the true designation of the figures, i.e., Figures 10A-E.

Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures

Art Unit: 3623

appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

5. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The Abstract exceeds the 150-word limit.

6. The disclosure is objected to because of the following informalities:

- Paragraph 0002, delete "an adverse such impact", and insert -- such an adverse impact --.
- Paragraph 0061, delete "representative..", and insert -- representative. --.
- Paragraph 0065, delete "721collects", and insert -- 721 collects --.

Art Unit: 3623

- Paragraph 0065, delete "Reporting module 748", and insert -- Reporting module 747 --. See drawing objection above.
- Paragraph 0082, delete "Also , portfolio", and insert -- Also, portfolio --.

The above citation is a mere guide. Applicant is requested to review the specification thoroughly to eliminate additional errors.

Claim Objections

7. **Claim 1** is objected to because of the following informalities: delete "utilzing", and insert ***--utilizing--***. Appropriate correction is required.

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-55 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1, 19, 37 and 55 calculate and output a sustainability score. Claim 55 adds the feature of conveying at least a portion of the data aurally. Specifically, using a computer, data that is accessible to the user is used with a coefficient value that is inputted by the user, and the computer along with the data and coefficient value, computes a sustainability score using at least one non-economic factor in a formula that is viewable and then outputs the sustainability score. The claims consist solely of a mathematical operation without some claimed practical application. That is, the claims simply compute a sustainability score without any

Art Unit: 3623

practical application of the sustainability score. Therefore, since the claimed process manipulates only numbers, abstract concepts, or ideas, or signals representing any of the foregoing, the claims are not being applied to appropriate subject matter and therefore are considered to be directed to non-statutory subject matter. See *Schrader*, 22 F.3d at 294-95, 30 USPQ2d at 1458-59.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. **Claims 1, 2, 19, 20, 37, 38 and 55** are rejected under 35 U.S.C. 102(b) as being anticipated by O'Connor (O'Connor, The RioJo Dashboard of Sustainable Development Indicators, July 2002 [GOOGLE]). O'Connor discloses sustainability ratings and benchmarking for legal entities comprising:

- **[Claim 1]** providing an interface capable of displaying at least a portion of the data (p. 1, Para 3, O'Connor teaches a readily accessible, user-friendly tool that lets decision-makers, the media and the general public move freely through data and related "meta-data". Its solution is to distill matrices of data into "dashboards" or instrument panels gauging broad similarities and differences in national progress on sustainability, over time and relative to other nations. Its RioJo Dashboard can be downloaded and includes hyperlinks to CSD "meta-data," online databases of international organizations that were sources of most underlying data, and authoritative national sources for test countries.);
- enabling a user to input at least one coefficient value through the interface (p. 2, Para 3, and p. 5, Para 3, O'Connor teaches the dashboards advanced applications invite users to consider actual data in different ways by redefining

Art Unit: 3623

- ranges and investigating "outliers". The software used allows for more sophisticated "weighting" schemes within and across clusters (by choosing the "weight your set" option in extended help).);
- computing a sustainability score using the coefficient value and the data, the sustainability score utilizing the at least one non-economic factor in a formula that is viewable by the user through the interface (p. 4, Para 2, p. 5, Para 3, p. 6, Para 4, p. 10, Para 1, O'Connor teaches the Dashboard calculates and displays a Sustainable Development Index (SDI). The dashboard presents data as range estimates that appear as discrete values, or point estimates, in underlying sources. The software used allows for more sophisticated "weighting" schemes within and across clusters (by choosing the "weight your set" option in extended help). An OECD, United Nations, World Bank conference identified six social goals and 16 complementary indicators to be monitored.); and
 - outputting the sustainability score (p. 1, Para 3, p. 2, Para 3, p. 10, Para 1, O'Connor teaches a readily accessible, user-friendly tool that lets decision-makers, the media and the general public move freely through data and related "meta-data". Its solution is to distill matrices of data into "dashboards" or instrument panels gauging broad similarities and differences in national progress on sustainability. The dashboards advanced applications invite users to consider actual data in different ways by redefining ranges and investigating "outliers". The Dashboard calculates and displays a Sustainable Development Index (SDI).).
 - **[Claim 2]** storing the user-input coefficient value in an account associated with the user (p. 6, Para 1, O'Connor teaches the system allows users to save and exchange smoothing preferences.).

Claims 19, 20, 37, 38 and 55 substantially recite the same limitations as that of claims 1 and 2 with the distinction of the recited method being a computer and another method. Hence the same rejection for claim 1 and 2 as applied above applies to claims 19, 20, 37, 38 and 55.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. **Claims 12-18, 30-36 and 48-54** are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Connor (O'Connor, The RioJo Dashboard of Sustainable Development Indicators, July 2002 [GOOGLE]) in view of Burt et al. (Australian Patent Application AU 2002301158 A1). As to claim 12, O'Connor discloses sustainability ratings and benchmarking for legal entities but fails to teach the sustainability score includes a plurality of individual scores corresponding to discrete sustainability criteria. Burt et al. teach the environmental criteria are subdivided into the following categories: Land, Building, Water, Energy, Procurement, and Outputs. The social criteria are subdivided into the following categories: Physical, construct, Industrial Relations, Occupational Health and Safety, Guest Satisfaction, Supplier Guidelines and Other Stakeholder Interaction (p. 10, lines 13-24). It would have been obvious to one of ordinary skill in the art at the time of the applicants invention to modify O'Connor with the environmental and social criteria of Burt et al. since O'Connor teaches the World Bank conference identified six social goals and 16 complementary indicators to be monitored (p. 6, Para 4). Establishing strategic priorities or goals help decision-makers make sound judgments and decision that reflect the intent of the strategic priorities and goals. O'Connor teaches a detailed description of key sustainable development

Art Unit: 3623

themes/sub-themes and a Commission on Sustainable Development (CSD) approach to improving indicators of sustainable development for decision-making at the national level (p. 1, Para 1). Burt et al. teach a system and method for assessing property investments that apply predetermined financial and social responsibility criteria to the investment. Both O'Connor and Burt et al. teach applying a criteria or theme, i.e., strategic priority or goal, to improve either indicators or investments, therefore there is a motivation or suggestion to combine. There is a reasonable expectation of success since both O'Connor and Burt et al. teach a sustainability index, and the combination of O'Connor and Burt et al. teach all the elements of the claimed invention.

- **[Claim 13]** the coefficient value is used to compute at least one of the individual scores (Burt et al.: p. 15, line 28 to p. 16, line 2, Burt et al. teach the total points comprising the index is 320 being 100 points for each of the financial criteria, the environmental criteria and the social criteria and 20 points for the reporting transparency criteria. Points are not equally allocated to each category of each of the criteria. Points are allocated to each category in dependence on the relative importance of the category to sustainability principles. Table 7, shows multiple assessed scores with the environmental sustainability index score computed.).
- **[Claim 14]** the sustainability score is computed by combining at least two of the individual scores (Burt et al.: Tables 7 and 8, Burt et al. teach in regard to Tables 7 and 8, the left hand column are the total points for the particular category, the number under the heading "Max. points" are the maximum points available for each sub-category of the particular category, and the points that are awarded for each sub-category are under the heading "Award Points".), and
- the coefficient value is used to affect how the individual scores are combined (Burt et al.: p. 22-26, Tables 8, Burt et al. teach in regard to Table 8 the assessment process to take into account the "weighting" factor of the particular criteria.).
- **[Claim 15]** the discrete sustainability criteria include at least one of a social responsibility rating, an environmental responsibility rating, and a corporate governance rating (Burt et al.: p. 15, line 28 to p. 16, line 2 and p. 34, line 4 to

Art Unit: 3623

page 35, line 6, Burt et al. teach the total points comprising the index is 320 being 100 points for each of the financial criteria, the environmental criteria and the social criteria and 20 points for the reporting transparency criteria. The transparency criteria includes the criteria that the index should be prepared or certified by a suitably, qualified, independent expert, and the results of the index should be published to demonstrate commitment toward sustainability. The examiner interprets the transparency criteria as the corporate governance rating.).

- **[Claim 16]** the discrete sustainability criteria further include an economic rating (Burt et al.: p. 15, line 28 to p. 16, line 2 and p. 34, line 4 to page 35, line 6, Burt et al. teach the total points comprising the index is 320 being 100 points for each of the financial criteria, the environmental criteria and the social criteria and 20 points for the reporting transparency criteria.).
- **[Claim 17]** benchmarking the sustainability score against a reference score (Burt et al.: p. 6, lines 29-33; Burt et al. teach in respect of the financial criteria, points may be awarded based solely on the property's return on accumulative investment cost relative to a benchmark return.).
- **[Claim 18]** the data concerns non-economic factors for multiple governments (O'Connor: p. 1, Para 3, O'Connor teaches a user-friendly tool that distills matrices of data into "dashboards" or instrument panels gauging broad similarities and differences in national progress on sustainability, over time and relative to other nations.),
- the interface further enables the user to select one of the governments (O'Connor: p. 2, Para 5, O'Connor teaches to reach data, country and time must be added to the "dimension-less" CSD Thematic Framework, forming and "info-cube" whose sides are covariant.), and
- computing uses the data concerning the selected one of the governments (O'Connor: p. 3, Para 1, O'Connor teaches the RioJo Dashboard offers a "meta-indicator" that counts indicators reported for each country, at each time. The examiner interprets "meta-indicator" to be calculated.).

Claims 30-36 and 48-54 substantially recite the same limitations as that of claims 12-18 with the distinction of the recited method being a computer. Hence the same rejection for claims 12-18 as applied above applies to claims 30-36 and 48-54.

Allowable Subject Matter

13. **Claim 3-11, 21-29 and 39-47** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure

- Ichihari et al. (U.S. Patent Application 2003/0046203 A1) disclose a performance index processing system that brings sustainable growth to the company to be in harmony with society.
- Hallerbach et al. (Hallerbach et al., A Framework for Managing a Portfolio of Socially Responsible Investments, European Journal of Operational Research, copyright 2003 [GOOGLE]) disclose socially responsible investing using a multi-criteria decision tool.
- Maggioncalda et al. (U.S. Patent 6,012,044) discloses a user interface for a financial advisory system.

Art Unit: 3623

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Michael C. Heck whose telephone number is (571) 272-6730. The Examiner can normally be reached Monday thru Friday between the hours of 8:30am - 4:30pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq R. Hafiz can be reached on (571) 273-6729.

Any response to this action should be mailed to:

**Director of the United States Patent and Trademark Office
P.O. Box 1450
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[Informal/Draft communication, labeled "**PROPOSED**" or "**DRAFT**"]

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mch

07 November 2005


TARIQ R. HAFIZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600